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10/812,040	03/29/2004	Beat Heer	A01509	1451

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EXAMINER

NEPVEUX, FELIX JOSEPH

ART UNIT PAPER NUMBER

1617

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,040	<b>Applicant(s)</b> HEER ET AL.	
	<b>Examiner</b> Felix J. Nepveux	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08).<br>Paper No(s)/Mail Date <u>06/24/04; 08/16/04</u> <u>11/26/04</u> & <u>3/08/05</u> | 6) <input type="checkbox"/> Other: ____  |



**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10811518 in view of Wolfgang et al. (WO 98/33380).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are overlapping in scope. The compositions of Application No. 10811518 (claims 1-8) comprise (a) at least one

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sulfur-containing s-triazine; (b) at least one pyrithione compound; and (c) and at least one additional microbicide selected from 2-alkyl-4-isothiazolin-3-ones and halopropynyl carbamates.

The compositions of 10811518 (claims 1-8) do not teach at least one 2-alkyl-4-isothiazolin-3-one and at least one halopropynyl carbamate.

Wolfgang et al. teaches a microbicidal composition used in coatings, paints, adhesives, etc., comprising **1)** 2.0 to 25.0% zinc pyrithione. **2)** 2.0 to 15.0% 2-methyl-4-t-butylamino-6-cyclopropylamino-s-triazine, and **3)** up to 10% N-octylisothiazolone. Wolfgang et al. also teaches a microbicidal composition comprising **1)** 2.0 to 25.0% zinc pyrithione and **2)** 2.0 to 15.0% 2-methyl-4-t-butylamino-6-cyclopropylamino-s-triazine (See page 25, claim 4; page 26, claims 6 and 8; page 7, lines 1-13; and page 9, lines 34-37; and page 10, lines 1-4, for example). Wolfgang et al. also teaches a composition comprising 4.38% 2-methylthio-tert-butylamino-6-cyclopropylamino-s-triazine (Irgarol 1051) and 5.0% iodopropynyl butylcarbamate (page 11, lines 29-33, for example).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate at least one 2-alkyl-4-isothiazolin-3-one and at least one halopropynyl carbamate in the composition of Application No. 10811518 (claims 1-8).

One of ordinary skill in the art would have been motivated to at least one 2-alkyl-4-isothiazolin-3-one and at least one halopropynyl carbamate in the composition of Application No. 10811518 (claims 1-8) because Wolfgang teaches several combinations of microbicidal compositions that include

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isothiazolin-3-ones and halopropynyl carbamates. Therefore, combining at least one 2-alkyl-4-isothiazolin-3-ones and at least one halopropynyl carbamates in the composition of Application No. 10811518 (claims 1-8) would have been reasonably expected to be effective as a microbicide that could be used in paints, adhesives, etc. Since Wolfgang's combining agents are known to be microbicides, which are individually useful for the very same purpose, the single composition is considered *prima facie* obvious. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). This is a provisional obviousness-type double patenting rejection.

Claims 1-8 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-10 of copending Application No. 10811518.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are overlapping in scope. The compositions of Application No. 10811518 (claims 9-10) comprise (a) at least one sulfur-containing s-triazine; (b) at least one pyrithione compound; and (c) at least one 2-alkyl-4-isothiazolin-3-ones, and (d) at least one halopropynyl carbamate, while the composition of the instant Application comprises a) at least one 2-alkyl-4-isothiazolin-3-one (b) at least one halopropynyl carbamate, and (c) at least one sulfur-containing s-triazine. Therefore the composition of the instant application is broader in scope than the composition of Application No. 10811518 (claims 9-10), and the said claims are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10812127 in view of Wolfgang et al. (WO 98/33380).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are overlapping in scope. The composition of Application No. 10812127 comprises (a) at least one sulfur-containing s-triazine and (b) at least one pyrithione compound, while the composition of the instant application a) at least one 2-alkyl-4-isothiazolin-3-one (b) at least one halopropynyl carbamate, and (c) at least one sulfur-containing s-triazine.

The composition of 10812127 does not teach at least one 2-alkyl-4-isothiazolin-3-one and at least one halopropynyl carbamate.

Wolfgang et al. teaches a microbicidal composition used in coatings, paints, adhesives, etc., comprising **1)** 2.0 to 25.0% zinc pyrithione. **2)** 2.0 to 15.0% 2-methyl-4-t-butylamino-6-cyclopropylamino-s-triazine, and **3)** up to 10% N-octylisothiazolone. Wolfgang et al. also teaches a microbicidal composition comprising **1)** 2.0 to 25.0% zinc pyrithione and **2)** 2.0 to 15.0% 2-methyl-4-t-butylamino-6-cyclopropylamino-s-triazine (See page 25, claim 4; page 26, claims 6 and 8; page 7, lines 1-13; and page 9, lines 34-37; and page 10, lines 1-4, for example). Wolfgang et al. also teaches a composition comprising 4.38% 2-

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methylthio-tert-butylamino-6-cyclopropylamino-s-triazine (Irgarol 1051) and 5.0% iodopropynyl butylcarbamate (page 11, lines 29-33, for example).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate at least one 2-alkyl-4-isothiazolin-3-one and at least one halopropynyl carbamate to the composition of Application No.

10812127.

One of ordinary skill in the art would have been motivated to incorporate at least one 2-alkyl-4-isothiazolin-3-one and at least one halopropynyl carbamate to the composition of Application No. 10812127 because Wolfgang teaches several combinations of microbicidal compositions that include isothiazolin-3-ones, halopropynyl carbamates, pyrithiones and sulfur-containing s-triazines. Since Wolfgang's combining agents are known to be microbicides, which are individually useful for the very same purpose, the single composition is considered *prima facie* obvious. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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Claims 1-4 are rejected under 35 U.S.C. 102(a) as being anticipated by Hisanari (JP2002-316903-A, 10/31/2002).

Hisanari teaches an algacide composition used in paints comprising 23.0% by weight of 2-methylthio-4-t-butyl amino-6-cyclopropylamino-s-triazine, 7.0% by weight of 2-N-octyl-4-isothiazolin-3-one, and 7.0% by weight of 3-iodo-2-propynyl carbamate, (See claims 4, 7, and 10, for example).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisanari (JP2002-316903-A, 10/31/2002) as applied to claims 1-4.

Hisanari teaches an antialgae composition used in paints comprising 23.0% to 71.4% by weight of 2-methylthio-4-t-butyl amino-6-cyclopropylamino-s-triazine, 7.0% to 57.1% by weight of 2-N-octyl-4-isothiazolin-3-one, and 7.0% to 57.1% by weight of 3-iodo-2-propynyl carbamate, (See claims 4, 7, and 10, for example).

Hisanari does not teach **1)** the compositions of instant claims 5-8 wherein the said at least one substituted or unsubstituted 2-(C<sub>4</sub>-C<sub>10</sub>) alkyl-4-isothiazolin-3-one is present in a total amount from 0.2% to 5%; **2)** the composition of instant



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claims 7-8 wherein the said at least one 2-N-alkyl-4-N-alkyl-6-alkylthio-1,3,5-triazine-2,4-diylamine is present in a total amount from 1.5% to 15%.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the percentages of 2-alkyl-4-isothiazolin-3-one, halopropynyl carbamate, and sulfur-containing s-triazine.

One of ordinary skill in the art would have been motivated to optimize the percentages of the 2-alkyl-4-isothiazolin-3-one, the halopropynyl carbamate, and the sulfur-containing s-triazine because Hisanari teaches a range of percentages for the active agents, which are all well known algaecides, and optimizing the percentages of the active agents would have been reasonably expected to be effective for finding the best possible algaecide for paints.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix J. Nepveux whose telephone number is (571) 272-8514. The examiner can normally be reached on m-f 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Felix J. Nepveux V



SAN-MINGHUI  
PRIMARY EXAMINER